

REMARKS

The Office Action dated September 10, 2004 presents the examination of claims 1-18. Claim 18 is canceled. Claims 1-3, 5, 8-12, and 16-17 are amended. No new matter is inserted into the application.

Information Disclosure Statement

In reviewing the application file, the undersigned has noted that the appropriate initialed Forms PTO-1449 in response to the Information Disclosure Statements (IDS) filed on April 24, 2002, May 21, 2002, October 17, 2002, November 12, 2002, January 15, 2003, and January 23, 2003 have not been received by Applicant. The Examiner is therefore requested to return a copy of the initialed Forms PTO-1449 to the undersigned as soon as possible.

Priority under 35 U.S.C. 119

On the Office Action Summary page, the Examiner indicates that none of the certified copies of the priority documents have been received. Applicants respectfully submit that certified copies of priority documents JP 2000-401417 (December 28, 2000), JP 2001-006910 (January 15, 2001), JP 2001-227094 (July 27, 2001), and JP 2001-294795 (September 26, 2001) were filed in the USPTO on November 2, 2001. The postcard receipt date-stamped by the USPTO

will follow. The Examiner is respectfully requested to acknowledge receipt of the priority documents.

Specification

The Examiner objects to the abstract of the disclosure for consisting of more than one paragraph. Applicants submit herewith a corrected abstract as required by the Examiner. Thus, the instant objection is overcome.

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner rejects claims 1-18 under 35 U.S.C. § 112, second paragraph for allegedly being indefinite. Claim 18 is canceled, thus rendering the rejection thereof moot. Applicants respectfully traverse the rejection applied to the pending claims. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

Specifically, the Examiner states that the recitation of "a part or all of protein components that are labeled with one of a pair of substances adhering to each other" in the claims and specification is unclear. In response to the Examiner's remarks, this phrase is amended to "at least one protein component of the reaction system is labeled with a first substance which adheres to a second substance, and said second substance is used as an

absorbent for capturing said labeled component after said translation." In addition, the phrase "characterized in that" is amended to "wherein" in order to better conform the claims to current U.S. practice.

The amendment of "pair of substances" to a "first substance" and a "second substance" is not new matter since the word "pair" implies, for example, two corresponding things designed for use together, or two corresponding members. Other minor grammatical and idiomatic amendments are made to the specification and claims in order to clarify the present invention.

Applicants respectfully submit that the instant claims particularly point out and distinctly claim the subject matter which is Applicants' invention. Withdrawal of the instant rejection is therefore respectfully requested.

Rejection under 35 U.S.C. § 102(a)

The Examiner rejects claims 1-11 and 18 under 35 U.S.C. § 102(a) for allegedly being anticipated by Shimizu et al. (*Nature Biotechnology*, 19:751-755, 2001). Claim 18 is canceled, thus rendering the rejection thereof moot. Applicants respectfully traverse the rejection applied to the pending claims. Reconsideration of the claims and withdrawal of the instant rejection are respectfully requested.

In order to overcome the rejection, Applicants submit herewith verified English translations of the priority documents JP 2000-401417 (December 28, 2000), JP 2001-006910 (January 15, 2001), JP 2001-227094 (July 27, 2001), and JP 2001-294795 (September 26, 2001). The priority documents satisfy the enablement and written description requirements of 35 U.S.C. § 112, first paragraph. Since the filing dates of the priority documents antedate the reference date, Shimizu et al. is not available as prior art. Withdrawal of the instant rejection is therefore respectfully requested.

Conclusion

Applicants respectfully submit that the above remarks and/or amendments fully address and overcome the outstanding rejections and objections. For the foregoing reasons, Applicants respectfully request the Examiner to withdraw all of the outstanding rejections and objections, and to issue a Notice of Allowance indicating the patentability of the present claims. Early and favorable action of the merits of the present application is thereby respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kristi L. Rupert, Ph.D. (Reg. No. 45,702) at the telephone number of the undersigned below, to conduct an

interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Kurt L. Rupert #45,702
for Gerald M. Murphy, Jr., #28,977

GMM/KLR

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment(s):

- Abstract;
- Verified English translations of JP 2000-401417 (December 28, 2000), JP 2001-006910 (January 15, 2001), JP 2001-227094 (July 27, 2001), and JP 2001-294795 (September 26, 2001).